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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,139	06/20/2003	Keith Weinstein	PMW1110-2	5941
28213	7590	03/21/2006	EXAMINER	
DLA PIPER RUDNICK GRAY CARY US, LLP 4365 EXECUTIVE DRIVE SUITE 1100 SAN DIEGO, CA 92121-2133			WYSZOMIERSKI, GEORGE P	
			ART UNIT	PAPER NUMBER
			1742	

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/601,139	Applicant(s) WEINSTEIN, KEITH	
	Examiner George P. Wyszomierski	Art Unit 1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-19 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3-7 and 9 is/are allowed.
- 6) ☒ Claim(s) 2,10-14 and 18 is/are rejected.
- 7) ☒ Claim(s) 15,16,17 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Claims 2, 10, 11 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) In claim 10, line 3, it appears that the phrase "about 2% to 14% by weight" should be deleted, i.e. the alloy referred to in the preamble of the claim is not 2-14% of the recited elements, but rather 2-14% of the overall composition of the solder.

b) In claims 2 and 11, it is unclear whether the copper defined in these claims is a part of the copper defined in the independent claims, or a separate component of the claimed composition. Further, the claims recites 8% to 80% silver, while the independent claims require a minimum of 25% gold and 2% other elements, and claims 2 and 11 also require a minimum of 5% zinc, so it is unclear how the 80% level could be attained in a manner consistent with the remainder of the claimed limitations.

c) It appears that line 2 of claim 18 should be rewritten as "and about 2% to 14% by weight of an alloy for lowering the melting point of the solder comprising".

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 10, 12, 13, 14 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nawaz (U.S. Patent 4,591,483).

Nawaz discloses alloys containing 20-65% gold, and which may further comprise gallium, indium and copper in amounts overlapping the amounts as defined in the instant

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claims. Nawaz does not disclose any specific examples having the Ga:In:Cu ratio as presently claimed. However, the composition as broadly recited in e.g. claim 1 of Nawaz overlaps the composition as presently claimed. In view of the overlap, the disclosure of Nawaz is held to create a prima facie case of obviousness of the presently claimed invention because Nawaz indicates that the prior art compositions possess utility over the entire range as claimed in the prior art patent. Compare *In re Malagari* (182 USPQ 549).

4. In a response filed January 4, 2006, Applicant alleges that the melting temperature of the Nawaz alloys are significantly higher than those presently claimed. Applicant's arguments have been carefully considered, but are not applicable to the rejected claims because these claims do not recite any specific melting temperature. With respect to dental alloys in Nawaz versus solder in the instant claims, this is held to be nothing more than a difference in intended use of the claimed materials, and does not define any difference between the actual compositions of the prior art and those of the instant claims.

The terminal disclaimer filed on January 4, 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent 6,372,060 has been reviewed and is accepted. The terminal disclaimer has been recorded.

All amendments made in the January 4, 2006 response appear to be fully supported by the specification as originally filed. The last line of claim 10 appears to find support at paragraph [0023] of the specification.

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5. Claims 1, 3-7 and 9 are allowable over the prior art of record, and claims 15, 16, 17 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

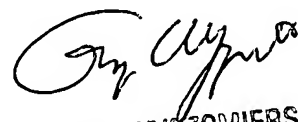
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Wyszomierski whose telephone number is (571) 272-1252. The examiner can normally be reached on Monday thru Friday from 8:00 a.m. to 4:30 p.m. Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached on (571) 272-1244. All patent application related correspondence transmitted by facsimile must be directed to the new central facsimile number, (571)-273-8300. This new Central FAX Number is the result of relocating the Central FAX server to the Office's Alexandria, Virginia campus.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GPW
March 16, 2006


GEORGE WYSZOMIERSKI
PRIMARY EXAMINER
GROUP 1742